REMARKS

Claim 1 is amended. Claims 6-21 were previously canceled without prejudice or disclaimer. No new matter is added by these amendments. Claims 1-5 and 22-25 are pending. By amending and canceling the claims, applicant is not conceding that the claims are non-statutory under 35 U.S.C. 101, 102, 103, and 112 and is not conceding that the claims are unpatentable over the references cited by the Office Action, as the claim amendments are only for the purpose of facilitating expeditious prosecution. Applicant respectfully reserves the right to pursue the subject matter of the claims as it existed prior to any amendment or cancellation and to purse other claims in one or more continuation and/or divisional applications. Applicant respectfully requests reconsideration and allowance of all claims in view of the amendments above and the remarks that follow.

Claim Rejections under 35 U.S.C. 112

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 112 because "'a determination whether the trend at the client device is increasing during the estimated time period' is unclear." Claim 1 is amended to recite "increases," which is definite under 35 U.S.C. 112. Claims 2-5 and 22-25 are definite for depending on claim 1.

Claim Rejections under 35 U.S.C. 101

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 101 because "the claimed invention is directed to non-statutory subject matter." Applicant respectfully traverses these grounds for rejection because claim 1 recites: "the client electronic device displays the associated recommended offering via an output device," so the output device is transformed to a different state, so claim 1 is statutory under 35 U.S.C. 101.

Further claim 1 recites: "saving the data at the server electronic device," so the server electronic device is transformed to a different state, so claim 1 is statutory under 35 U.S.C. 101.

Claims 2-5 and 22-25 are statutory under 35 U.S.C. 101 for depending on claim 1.

Non-Statutory Obvious-Type Double Patenting Rejections

Claims 1-5 and 22-25 were rejected on the grounds of non-statutory obviousness-type double patenting over claims 1-4 of Birkholz (U.S. Patent No. 7,055,149 B2). Applicant respectfully traverses these grounds for rejection.

The Examiner has the burden to show that (1) the inventions claimed (2) are not patentably distinct and (3) are based on a prima facie showing of obviousness. This analysis must be based on what the claim defines and not on the claim language itself, as required by the Federal Circuit:

[I]t is important to bear in mind that comparison can be made only with what invention is *claimed* in the earlier patent, paying careful attention to the rules of claim interpretation to determine what invention a claim *defines* and not looking to the claim language for anything that happens to be mentioned in it as though it were a prior art reference. ... [W]hat is claimed is what is *defined by the claim taken as a whole*, every claim limitation ... being material. General Foods Corp. V. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 23 USPQ 2d, 1839, 1845 (Fed. Cir. 1992). (emphasis in original.)

Applicant respectfully submits that the Office Action has not made a prima facie case of non-statutory obviousness-type double patenting because the Office Action did not consider the Birkholz claims as a whole. Instead, the Office Action picked certain elements of the Birkholz claim 2 to compare with applicant's claims while ignoring other elements of the Birkholz claim 2 as if the Birkholz claim 2 were a prior art reference, which is expressly prohibited by the doctrine of non-statutory double patenting. For example, the Office Action ignored the "verifying one or more business contracts" element in the Birkholz claim 2, which is not present in applicant's claims.

Applicant further respectfully submits that the Office Action did not make out a prima facie case of non-statutory double patenting because the Office Action did not

reject the claims with specificity. 37 CFR § 1.104(a)(2) recites: "The reasons for any adverse action or any objection or requirement will be stated in an Office action." Further, MPEP 707.07(d) recites: "Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated."

The Office Action stated that claims 1-5 and 22-25 are rejected over claims 1-4 of Birkholz, but the Office Action made no arguments with respect to claims 2-5 and 22-25 of applicant's application and made no arguments and gave no reasons for rejecting applicant's claims over claims 2-4 of Birkholz, so the Office Action did not state the reasons for the adverse action or fully and clearly state the grounds for rejection.

Further, the Office Action impermissibly ignored and made no argument regarding the element of "wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period," which is not taught or suggested by claims 1-4 of Birkholz.

Claim Rejections under 35 U.S.C. 102

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 102(e) over Hayward (US Patent Number 6,798,997 B1). Applicant respectfully submits that the claims are patentable over Hayward because Hayward does not teach or suggest all elements of the claims for the reasons argued below.

Claim 1 recites: "comparing, at the server electronic device, a subset of the plurality of fields to a plurality of thresholds via a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the plurality of thresholds to values in subset of the plurality of fields, and specify an associated recommended offering, wherein the subset of the plurality of fields of the data comprises a trend at the client electronic device, wherein the trend comprises a rate of growth of consumption of a resource at the client electronic device and an estimated time period until the resource is constrained, and wherein one of the plurality of conditions specifies a

determination whether the trend at the client electronic device increases during the estimated time period," which is not taught or suggested by Hayward for the reasons argued below.

In contrast to claim 1, Hayward at column 5, lines 6-23 recites: "Conditions in the machine 10 may indicate a need to replace a consumable item or part (e.g., paper, ink, toner, cartridge, printhead, drum). Using the sensed indicia from registration, an automatic electronic customer direct supply ordering mechanism can advantageously identify a replacement part or consumable item that is needed and the proper part can then be automatically ordered and sent to the user. For example, a particular condition may be determined or derived from sensors 12 and machine state 14 via firmware 16 as shown in FIG. 2. The peripheral condition is sent by firmware 16 over bus 32 to an application program running in the computer 30. Moreover, a particular condition may be determined or derived from sensors 12 and consumable component 11 via processor, software and logic system 16 as shown and further described with respect to FIG. 8. The applications program may indicate the particular condition to the user, for example on a display screen."

In further contrast to clam 1, Hayward at column 6, lines 28-43 recites: "When a user accesses the status window and clicks the "Show Me" button, the application program may access replacement instruction information related to replacing a customer replaceable unit, for example, the magenta ink cartridge. FIG. 6 depicts this "Show Me" process as step S2. In step S21, the application program senses the particular peripheral condition. The application program running in computer 30 receives the peripheral condition over the bus 32 from the firmware 16 (FIG. 2). In step S22 (FIG. 6), the application program checks to see if the information is already present in the memory of computer 30. If the information is not present, the application program in step S23 launches an embedded or an external communications browser to access the manufacturer's server or vendor's server at an address defined by the peripheral condition."

Thus, in Hayward, the machine 10, also called a "peripheral 10 (e.g., fax, copier, printer and scanner device)," at column 4, lines 10-11, "determine[s] or derive[s] from sensors 12 and machine state 14 via firmware 16" "a particular condition" and sends it "over bus 32 to an application program running in the computer 30." This "condition," which was determined by the peripheral 10 "indicate[s] when a consumable has been exhausted (e.g., paper tray empty) or a consumable has reached a predetermined threshold," as described by Hayward at column 8, lines 26-29. In response to receiving the condition from the peripheral, the application program running in the computer 30 "access[es] the manufacturer's server or vendor's server at an address defined by the peripheral condition," as described by Hayward at column 6, lines 35-44.

Thus, Hayward does not teach or suggest "comparing, at the server electronic device, a subset of the plurality of fields to a plurality of thresholds via a plurality of conditions, wherein the plurality of conditions specify the subset, specify a comparison of the plurality of thresholds to values in subset of the plurality of fields, and specify an associated recommended offering, wherein the subset of the plurality of fields of the data comprises a trend at the client electronic device, wherein the trend comprises a rate of growth of consumption of a resource at the client electronic device and an estimated time period until the resource is constrained, and wherein one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period," as recited in claim 1 because it is the Hayward peripheral 10 that detects the condition which "indicate[s] when a consumable has been exhausted," and the Hayward computer 30 merely accesses an address defined by the peripheral condition, but the Hayward computer 30 does no comparing, as recited in claim 1.

Claims 2-5 and 22-25 are dependent on claim 1 and are patentable for the reasons argued above.

Claim Rejections under 35 U.S.C. 103

Claims 1-5 and 22-25 are rejected under 35 U.S.C. 103(a) over Birkholz (U.S. Patent No. 7,055,149 B2) in view of Ballantine (US Patent Number 6,446,123 B1). Applicant respectfully submits that the claims are patentable over Birkholz and Ballantine because Birkholz and Ballantine do not teach or suggest all elements of the claims for the reasons argued below.

Claim 1 recites: "one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period," which is not taught or suggested by Birkholz and Ballantine for the reasons argued below.

In contrast to claim 1, Birkholz at column 11, lines 66-67 and column 12, lines 1-17 recites: "The recommendation table 310 is a result of the system sizer process 310. It represents one or more systems with resources capable of handling the requirements. FIG. 8 shows one embodiment of a record 812 contained in the recommendation table 310. Illustratively, the record 812 comprises several key data elements including a user entry 814, an estimated system attributes entry 816, and a time period entry 818. ... The time period indicates whether the estimated system meets the current requirements or for a future point in time (e.g., 12 months) as selected by the system sizer user."

Thus, the Birkholz "time period indicates whether the estimated system meets the current requirements or for a future point in time," so the Birkholz uses its "time period" to determine whether its "estimated system" meets its "current requirements" or its requirements "for a future point in time" and not whether Birkholz's current system meets its current requirements or its requirements for a future point in time, so Birkholz does not teach or suggest "one of the plurality of conditions specifies a determination whether the trend at the client electronic device increases during the estimated time period," as recited in claim 1 because claim 1 uses the "estimated time period" to determine whether the "trend at the client electronic device increases" and not whether a trend at a "recommended offering" increases.

In contrast, Ballantine at column 6, lines 24-47 recites: "By reading information from each component of system 100, health manager software tool 168 monitors other operational conditions and performance trends. This process allows health manager software tool 168 to learn from experience. For example, health manager software tool 168 can anticipate that Mother's day will be busy and predict that 2 a.m. on Monday morning will be quiet. To this end, health manager software tool 168 can determine system component performance based on anticipated system activity during a particular period of time. When tool 168 predicts component performance to exceed its associated threshold within a predetermined period (e.g., three months) based on monitored operational conditions and performance trends, health manager software tool 168 generates a warning alert (e.g., a flashing icon, an audible alarm, or other user-configurable device). As the end of the predetermined period gets closer, the health manager software tool 168 escalates the warning. In addition, health manager software tool 168 notifies a user of the time to threshold, estimated time to fix a network problem, details of the problem, probable cause of the problem, and impact to the network. Preferably, this information is presented to the user via a graphical user interface."

Thus, Birkholz estimates a system that meets requirements while Ballantine gives an escalating warning if actual component performance encounters a threshold problem. Hence, no suggestion exists to combine Birkholz with Ballantine because to do so would destroy the function of Birkholz and render Birkholz inoperable. Combining Birkholz with Ballantine would require the Birkholz estimated system to be ordered, received, configured, and operated until the Ballantine component performance exceeds its threshold, so that the Ballantine warning alert could be generated and then escalated, as the Ballantine predetermined period gets closer. But, such a modification renders Birkholz inoperable for its intended purpose because the purpose of Birkholz, as recited at column 1, lines 29-32 is for "ordering a customized software upgrade" and Birkholz accomplishes this purpose by estimating the Birkholz "estimated system" and determining whether the estimated system meets its "current requirements" or its requirements "for a future point in time." If Birkholz were modified to convert its estimated system into an actual system and to operate that system in order to present and

escalate a warning alert for component performance threshold problems, then no purpose is accomplished by estimating a system, so the operability of Birkholz is destroyed.

Claim 1 further recites: "the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering, and wherein the client electronic device displays the associated recommended offering via an output device," which is not taught or suggested by Birkholz and Ballantine for the reasons argued below.

In contrast to claim 1, Birkholz at column 15, lines 51-66 and column 16, lines 1-9 recites: "FIG. 18 shows a system recommendation GUI 1800. The GUI 1800 contain system recommendation information resulting from the recommend table and which will be passed to the comparison tool 202. Illustratively, from the set of all computer systems capable of supporting the specified workload, one system is shown (indicated as "immediate solution"). Additionally, a system adapted to the growth trend is shown (indicated as "growth solution"). The system information which may be displayed to the user for each solution includes model/feature, processor CPW, interactive CPW, database capacity, N-Way, processor utilization, software pricing tier and memory. The model/feature information is the selected system identification. Clicking a drop-down menu button 1802 provides a menu of all models capable of performing the specified work. The processor CPW is the computing capacity of the processor and the interactive CPW is the computing capacity of the processor with interactive applications and percentage of that capacity used. The database capacity is the percentage of the overall CPU to used perform database processing. The N-Way is the number of processors in this model. Processor utilization is the percentage of overall CPU consumed by the workloads defined. Software pricing tear is an ID of a group determining pricing for software and support. The memory indicates the amount of memory and (RAM) required and the maximum amount the system supports."

Thus, Birkholz at Fig. 18 describes its "system recommendation" and not the Birkholz current system, so Birkholz does not teach or suggest "the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering," as recited in claim 1 because the claim 1 "data comprises an inventory of components installed at the client electronic device" and not an inventory of the recommended offering.

In further contrast to claim 1, Birkholz at column 26, lines 66-67 and column 27, line 1 recites: "FIGS. 38-46 show illustrative embodiments of graphical user interfaces (GUIs) configured for facilitating a software upgrade request." Thus, the sentence: "Why should I use IBM Electronic Services" in Fig. 38 refers to services that facilitate a software upgrade request and not a reason why a software upgrade was made because the Birkholz "Electronic Service" facilitates the Birkholz "software upgrade request" and is not the Birkholz "system recommendation," so Birkholz does not teach or suggest "the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering," as recited in claim 1.

Ballantine also does not teach or suggest "the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering, and wherein the client electronic device displays the associated recommended offering via an output device," as recited in claim 1 because Ballantine recommends "corrective actions such as increasing the number of switches in the ICP 27B environment," as described by Ballantine at column 7, lines 51-54, but does not make offerings.

The Office Action argues that "wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for

a need for the recommended offering is "nonfunctional descriptive material, yielding no patentable weight."

Applicant respectfully disagrees because claim 1 recites: "sending a notification to the marketing channel computer, wherein the notification comprises a request to receive information regarding why the recommended offering was made, wherein the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering, and wherein the client electronic device displays the associated recommended offering via an output device." Thus, the "sending" of claim 1 is functional and the "information regarding why the recommended offering was made" is part of the definition of the notification, which is part of the definition of the sending. Further, the information why the recommended offering was made comprises a subset of the data, and the data was received via the "receiving" element, which is also functional. Thus, "the information regarding why the recommended offering was made comprises a subset of the data that explains a reason for a need for the recommended offering," further defines both the sending and receiving functional material of claim 1, so it deserves patentable weight.

Claims 2-5 and 22-25 are dependent on claim 1 and are patentable over Birkholz and Ballantine for the reasons argued above, plus the elements in the claims.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is requested. The Examiner is invited to telephone Applicant's attorney (651-645-7135) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 09-0465.

Respectfully submitted,

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